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09/816,624	03/23/2001	Walter Canis	END9-2000-0145US1	7110
23550 7590 08/29/2008 HOFFMAN WARNICK LLC 75 STATE STREET 14TH FLOOR ALBANY, NY 12207				
EXAMINER NEURAUTER, GEORGE C				
ART UNIT		PAPER NUMBER		
2143				
NOTIFICATION DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hwdpatents.com

# Office Action Summary

**Application No.**

09/816,624

**Applicant(s)**

CANIS ET AL.

**Examiner**

George C. Neurauter, Jr.

**Art Unit**

2143

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No./Mail Date: \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-28 are currently presented.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 18 August 2008 has been entered.

#### ***Response to Arguments***

Applicant's arguments filed 18 August 2008 have been fully considered but they are not persuasive.

The Applicant argues that the combined teachings of Pulsipher and Steele do not teach or suggest collecting device information and detail information from devices on the network by querying each device to retrieve the device and detail information. The Examiner respectfully is not persuaded by these remarks. As the Board of Patent Appeals and Interferences found in the decision mailed 2 April 2008, "Pulsipher discloses a network monitor which transmits and receives data packets to and from a network, wherein the network monitor discovers and monitors network topology and the topology data stored includes data as to whether an interface or device supports the

SNMP protocol (FF 1-2). As admitted by Appellants in the Appeal Brief at 9, Pulsipher implements collection stations that can share data (FF 3). We agree with the Examiner that the collection action of Pulsipher is a "retrieve" action. That is, Pulsipher does not merely inactively receive the data but rather actively monitors and collects the data." (page 12) Therefore, Pulsipher did disclose active retrieval of the device and detail information through queries by "discovering" this data from other devices through the use of the disclosed "sharing" of such data between the devices.

Regarding the Applicant's arguments regarding dependent claims 4, 8, 14, 20, and 26, they are moot in view of the new grounds of rejection that are given below.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12, 13, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5 948 055 to Pulsipher et al.

Regarding claim 12, Pulsipher disclosed a method for mapping a network, comprising the steps of:

installing collection tools on a collection apparatus; (column 6, lines 52-59)

communicating the collection apparatus with the network; (column 6, lines 26-28 and 36-45)

operating the collection tools to collect device identification and detail information from devices on the network by querying each device to retrieve the device identification and detail information (column 7, lines 41-57), wherein the detail information includes device characteristic information and software information (column 7, line 65-column 8, line 6);

analyzing the device identification and detail information; (column 8, lines 7-24)  
and

reporting the analyzed device identification and detail information. (column 8, lines 38-49)

Regarding claim 13, Pulsipher disclosed the system of claim 12.

Pulsipher disclosed wherein the collection apparatus comprises at least one processor. (column 6, lines 19-20)

Regarding claim 15, Pulsipher disclosed the system of claim 12.

Pulsipher disclosed wherein the analyzing step further the step of resolving any conflicts between device identification and detail information collected by different collection tools. (column 11, lines 8-19)

Regarding claim 16, Pulsipher disclosed the system of claim 12.

Pulsipher disclosed wherein the reporting step comprises the step of generating a mapping report based on the analyzed device identification and detail information. (column 8, lines 38-49)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-11, 14, and 17-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5 948 055 to Pulsipher et al in view of US Patent 6 282 175 to Steele et al.

Regarding claim 1, Pulsipher disclosed a system for mapping a network, comprising:

a collection system for collecting device identification and detail information ("topology data") from devices on the network by querying each device to retrieve the device identification and detail information, wherein the detail information includes device characteristic information and software information; (column 7, lines 41-57)

an analysis system for analyzing the collected device identification and detail information (column 8, lines 7-24)

a report system for generating a mapping report based on the analyzed device identification and detail information. (column 8, lines 38-49)

Pulsipher did not expressly disclose a timer system for collecting the device identification and detail information at predetermined scheduled times, however, Steele did disclose these limitations (see at least column 2, line 66-column 3, line 15)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since Steele discloses that collecting information concerning the operating system allows identification of what has changed in the configuration of a computer which aids in troubleshooting and management of a computer system network (column 2, lines 1-4). In view of these specific advantages and that the references are directed to collecting device identification and detail information about devices on a network, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of

endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Regarding claim 2, Pulsipher and Steele disclosed the system of claim 1.

Pulsipher disclosed wherein the collection system comprises at least one collection tool for collecting the device identification and detail information. (column 7, lines 41-57, specifically "network monitor")

Regarding claim 3, Pulsipher and Steele disclosed the system of claim 2.

Pulsipher disclosed wherein the analysis system comprises rules for resolving any conflicts between device identification and detail information collected by at least one collection tool. (column 11, lines 8-19)

Regarding claim 4, Pulsipher and Steele disclosed the system of claim 1.

Pulsipher disclosed wherein the device identification and detail information includes device identities, device types, device addresses, device characteristics, application software installed on the devices, and software characteristics of the devices on the network. (column 7, line 65-column 8, line 6)

Pulsipher does not disclose wherein the device identification and detail information includes operating system software installed on the devices, however, Pulsipher does disclose wherein the device may be a computer (column 7, line 67-column 8, line 2, specifically column 8, line 1).

Steele discloses wherein device identification and detail information includes operating system software installed on the devices (column 2, lines 32-40)



Pulsipher and Steele do not expressly disclose wherein the device identification and detail information includes device characteristics including amount of RAM and versions of operating systems and application software, however, Pulsipher and Steele do disclose wherein the device identification and detail information includes device characteristics, application software, and operating system information.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to that the device identification and detail information may include such specific aspects such as software and operating system version numbers and device characteristics such as the amount of RAM on a device since these were well known specific instances of such device characteristics and software detail information to those skilled in the art and one of ordinary skill, given a group of specific device characteristics and detail information, would have selected these specific elements and would have reasonably expected the system to operate in the same expected manner as disclosed in Pulsipher and Steele and such specific elements would not be critical to the operation of the system of the references such that these differences would be obvious in consideration of the operation of the claimed invention and the system of Pulsipher and Steele.

Claims 8, 14, 20, and 26 are also rejected since these claims recite a system, method, program product, and computer system that contain substantially the same limitations as recited in claim 4.

Regarding claim 5, Pulsipher discloses the system of claim 4 wherein the generated mapping report includes the device identities, device types, the device

addresses, the device characteristics, the software installed on the devices, and the software characteristics. (column 7, line 65-column 8, line 6; column 8, lines 38-49, specifically "topology data")

Pulsipher does not disclose wherein the generated mapping report includes operating system software installed on the devices, however, Pulsipher does disclose wherein the device may be a computer (column 7, line 67-column 8, line 2, specifically column 8, line 1).

Steele discloses wherein a generated mapping report includes operating system software installed on the devices (column 2, lines 13-15 and 32-40)

Claim 5 is rejected since the motivations regarding the obviousness of claim 4 also apply to claim 5.

Claims 9, 21, and 27 are also rejected since these claims recite a system, method, program product, and computer system that contain substantially the same limitations as recited in claim 5.

Regarding claim 6, Pulsipher and Steele disclosed the system of claim 1.

Pulsipher disclosed the system further comprising a permission system for gaining user access to the network. (column 6, lines 11-35 and 62-64)

Regarding claim 10, Pulsipher and Steele disclosed the system of claim 1.

Pulsipher disclosed wherein the report system outputs the generated report. (column 8, lines 38-49 and 52-54, specifically lines 41-49 and 52-54)

Claim 7 is rejected since claim 7 recites a system that contains substantially the same limitations as recited in claims 1-3 in combination.

Claim 11 is rejected since this claim recites a system that contains substantially the same limitations as recited in claim 6.

Claims 17-19 and 22 are rejected since these claims recite a program product that contains substantially the same limitations as recited in claims 1-3 and 6 respectively.

Claims 23-25 and 28 are rejected since these claims recite a computer system that contains substantially the same limitations as recited in claims 1-3 and 6 respectively.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is 571-272-3918. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger, can be reached on 571-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George C. Neurauter, Jr./  
Primary Examiner, Art Unit 2143